

REMARKS

I. Introduction/Amendment

Claims 1-36 and 41 are presently are pending, and claims 37-40 are withdrawn from consideration. Applicant appreciates the Examiner's withdrawal of the §112(1) rejection from the prior office action.

Each of independent Claims 1, 17, and 27 has been amended to reflect that the dead bank card is a "dead deposit card." Applicant regards this as already being inherent in the claims, as the dead bank card was already recited as being "associated with an inactive deposit account." Applicant regards "dead deposit cards" as recited in the amended claims as encompassing (dead) debit cards, check cards, ATM cards, and stored value cards (all referenced in the specification), but not credit cards or charge cards.

All claims remain rejected under §103 on grounds of obviousness. Applicant respectfully requests reconsideration in view of the following remarks.

II. Double Patenting Rejection

Applicant acknowledges double patenting rejection set forth by the Examiner. Applicant requests that the rejection be held in advance pending resolution of the prior art rejections on the claims.

III. Rejections Under 35 U.S.C. § 103

The Examiner's present rejection is based on the position that:

"Nonobviousness cannot be established by attacking the references individually, when the rejection is predicated upon a combination of prior art disclosures. See *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir.1986). The applicant has attacked the references individually, when rejection was made using a combination of *Melchione et al.*, *Walker et al.*, *Nabe et al.* and *Strock et al.*"

Office Action at 20. Applicant respectfully disagrees. Applicant not only showed the individual references fail to teach or suggest certain claim limitations, but Applicant further showed that the combination offered by the examiner failed to teach or suggest certain claim limitations. Applicant also notes that if Examiner is combining references without further modification justified by a further reference or ordinary design skill, then a showing that none of the cited references alone possesses a claim limitation defeats the combination. This is because, in such a rejection, the combination cannot supply an element that is missing from every reference in the combination.

It is well-established that a *prima facie* obviousness rejection must address the invention as a whole including all claim limitations. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 1740 (2007) (inquiry based on “the subject matter as a whole”, “claimed subject matter”); *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”). It follows from the invention-as-a-whole rule that an obviousness rejection based on a combination of references must teach or fairly suggest each of the claim elements. The examiner cites *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir.1986), for the proposition that an obviousness rejection based on a combination of references cannot be defeated by showing that a claim element is missing from each of the references individually. Office Action at 20. The *Merck* case does not support that broad proposition and is very distinguishable.

In *Merck*, the issue was whether the use of drug A for treatment of depression was obvious in view of drug B used for depression. Several references were cited by the examiner to show the known similarities in structure and properties between claimed drug A and known drug B. *Id.* at 1096. The portion of *Merck* cited by the Examiner related to an argument by the applicant

that a single reference **taught away** from the claimed invention. *Id.* at 1097 (“We also find untenable appellant's arguments that Petersen teaches away from appellant's invention. Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”). ***Merk* is inapplicable here where the argument the examiner rejects is not that a particular reference teaches away—instead, the issue here the cited art fails to disclose certain claim elements.¹ Moreover, *Merk*'s outcome was based on the applicant's focus on a single reference—here Applicant has done what the appellant in *Merk* did not, which is examine all of the cited references for their teachings.** The most that can be fairly taken from *Merk* is that an attack on a combination of references should not be limited to analyzing a single reference, rather, it should include an analysis of what every one of the references teaches. That is precisely what Applicant has done here in showing that every one of the cited references fails to teach or suggest certain limitations of the invention.

A. Claims 1-22, 24-26, and 41 Are Patentable Over the Cited Four-Part Combination

Claims 1-22, 24-26, and 41 stand rejected under 35 U.S.C. § 103 as rendered obvious by a 4-part combination of Melchione (US Pat. No. 5,930,764) in view of Walker (US Pub. No. 2008/0052225), further in view of Jones (US Pub. No. 2004/0117300), and further in view of Nabe (US Patent No. 7,305,364). Applicant respectfully submits that the references, considered alone or in combination, render the claimed invention obvious.

Dead Bank Card . . . Unsolicited . . . Associated with an Inactive Deposit Account

¹ Based on a Westlaw search, *Merk* has not been cited to or relied on in any published decision of the Federal Circuit or any District Court as authority for this issue.

In the latest Office Action, the Examiner acknowledges that the primary reference Melchione fails to teach sending (a) a dead bank card [dead deposit card], that is (b) unsolicited by the recipient, and that is (c) associated with an inactive deposit account. See Office Action at 4 (Melchione “do[es] not teach a dead bank card associated with an inactive bank account, and distributing the dead bank card to the person”); at 8 (Melchione “do[es] not teach an *unsolicited* dead bank card associated with an *inactive bank account* . . .); at 9 (Melchione “do[es] not teach issuing [a] dead bank card associated with a deposit account”) [emphasis in original].

Because Melchione fails to teach three separate claim elements, the Examiner turns to three separate references (Walker, Jones, and Nabe) to address the deficiencies in the primary reference.

Starting with Walker, the Examiner asserts that Walker teaches distribution of a dead bank card that is unsolicited. Walker, considered alone or in combination with Melchione, does not teach or suggest, creating unsolicited dead bank cards associated with an inactive deposit account and distributing those dead bank cards.

First, Applicant once again submit that the Examiner is ignoring limitations of Claims 1, 22, and 27, namely, that the claimed subject matter is directed to “dead bank cards” and “inactive deposit accounts.” Walker describes a dead credit card associated with a credit account, not a dead bank card associated with an inactive deposit account. A credit/loan account is not a deposit account and they are not treated the same in the financial services industry. For example, and as explained on pages 8 to 10 of the specification as filed, if a credit card customer is outside the banking footprint of an issuing bank, it may not be feasible to provide a bank card and account. To emphasize the distinction, Applicant has amended the claim to provide that the

claimed dead bank card is a “deposit account card” (e.g., a debit card), which obviously does not encompass the credit card of Walker.

The Examiner cites Jones as teaching a dead debit card to cure the deficiencies of Walker and Melchione. Jones is related to a payment card processing system that allows a payment card to be used on two different payment networks.² Jones describes utilizing a “dual card,” which is basically a single card that can be used a private label card and a bank card, thus reducing the number of card a consumer has to carry.³ Not surprisingly, part of the process is sending a user the “dual card.”⁴ When the dual card is distributed, it is associated with a live credit account, and a live bank account as evidenced by the fact that the user applies for the dual card.⁵ Thus, as with Melchione, the system in Jones must receive permission from a consumer before sending the card. Thus, Jones fails to cure the deficiencies of Walker and Melchione by failing to teach a dead bank card, as recited. Rather, Jones dual cards is a live card. Moreover, Jones does not teach an unsolicited card offering, because the recipient in Jones has applied for (requested) the dual card.

The Examiner cites Nabe to compensate for the deficiencies of Jones, Walker, and Melchione. Specifically, the Examiner cites Nable as teaching the distribution of a card to an inactive customer. However, like Walker, Nabe is directed to credit/loan accounts, not deposit accounts. Nabe uses a database of Inactive Auto Finance Customers to find possible leads for a potential financier of a new car.⁶ Using various marketing models (e.g., direct response model), Nabe selects a subset of former customers likely to purchase a direct loan for a car. Thus, just as

² Jones, par. [0002].

³ Jones, par. [0008], [0022].

⁴ Jones, Fig. 5A.

⁵ Jones, par. [0027]

⁶ Nabe, 8:63-15.

with Walker, Nabe is only directed to credit/loan accounts, not deposit accounts, and in any case, Nabe is unrelated to the claimed creating and distributing of an unsolicited dead bank card associated with an inactive deposit account. Thus, the Examiner has not considered the claimed invention as a whole but rather appears to be treating the claims as merely a laundry list of limitations.⁷

Independent Claim 17 recites similar features to those that distinguish Claim 1 from the asserted art. Accordingly, Applicant requests that the Examiner withdraw the rejection of Claim 17, as well as dependent Claims 18-22 and 24-26.

B. Claims 27-32

Claims 27-32 stand rejected as allegedly rendered obvious by Jones in view of Walker and further in view of Nabe.⁸ Applicant respectfully traverses this rejection of the claims as amended.

The combination of Jones and Walker suffers from *at least* a similar deficiency as the combination of Melchione and Walker: neither reference teaches or suggests “distributing a live credit card and an unsolicited dead bank card associated with an inactive deposit account to the customer if the application is approved and the customer is not an existing bank account holder,” as recited in Claim 27. As noted above, Jones is related to a payment card processing system that allows a payment card to be used on two different payment networks. Jones describes utilizing a “dual card,” or a single card that can be used a private label card and a bank card. When the dual card is distributed, it is associated with a live credit account, and a live bank

⁷ M.P.E.P. § 2141.02(I).

⁸ The Office Action indicates that the claims are rejected under 35 U.S.C. § 102(e), however since the rejection is presented in the form of a combination of three reference, Applicant assumes that the Examiner meant that the references qualify as § 102(e) prior art, but the basis of the rejection is § 103(a).

account as evidenced by the fact that the user applies for the dual card. Thus, as with Melchione, the system in Jones must receive permission from a consumer before sending the card. As explained above, the claimed invention does not suffer from this limitation.

The Office Action recognizes the deficiencies of Jones, and cites Walker and Nabe. However, as described above, neither Walker nor Nabe teaches or suggests a dead bank card associated with an inactive deposit account. Thus, Applicant respectfully submits that Claim 27 would not have been rendered obvious by Jones in view of Walker and Nabe because the references, alone or in combination, do not teach or suggest each and every limitation of the claims. Accordingly, Applicant requests that the Examiner withdraw the rejection of Claim 27, and Claims 28-32 *at least* in view of their dependency from an allowable base claim.

C. Claim 23

Claim 23 stands rejected as allegedly rendered obvious by Melchione in view of Walker and further in view of Strock et al. (US Pub. No. 2004/0122736). Applicant respectfully traverses this rejection.

Strock relates to a system and method for providing promotional rewards, so it clearly does not compensate for the deficiencies of Melchione and Walker as set forth regarding independent Claim 1. Accordingly, claim 23 is at least patentable by virtue of its dependency from Claim 1, and Applicant respectfully requests that the Examiner withdraw the rejection of this claim.

D. Claims 33-36

Claims 33 – 36 stand rejected as allegedly rendered obvious by Jones in view of Walker and further in view of Strock.⁹ Applicant respectfully traverses this rejection.

For the reasons noted above, Jones, Walker and Strock do not teach or suggest all of the limitations of Claim 27, thus, Claims 33-36 are *at least* patentable by virtue of their dependency from Claim 27. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of these claims.

⁹ Page 15 of the Office Action indicates that claim 33-36 is rejected over Jones in view of Strock, however, claim 33-36 are dependent claim considered to include all of the limitations of claim 27, thus, any obviousness combination must include Walker.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Dated: February 28, 2011

By: //Stephen T. Schreiner//
Stephen T. Schreiner
Registration No. 43,097

Goodwin|Procter LLP
901 New York Avenue, NW
Washington, DC 20001
(202) 346-4000 (telephone)